

Notice of Allowability

Application No.

10/811,270

Examiner

Jason L. Lazorcik

Applicant(s)

MONSALUD ET AL.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 6/6/2007 and the telephonic interview of 8/8/07.
2. ☒ The allowed claim(s) is/are 13-21, 23-31, 33, AND 34.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date _____
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☒ Other IDS Filed 7/27/2007.

DETAILED ACTION

EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Charles Sherman on August 8, 2007.

The application has been amended as follows:

In the specification, the text of page 1, lines 14-15 has been amended to read "This application is a continuation in part of U.S. Application Serial No. 10/299,231 filed November 19, 2002, now U.S. Patent. 6,827,087."

Claims 1-12 are cancelled for being drawn to a non-elected invention in accordance with MPEP §821.01.

In the claims, Claim 34 has been rewritten as follows: 34/(Currently Amended)
The sheet of claim [32] 33 wherein said plurality of longitudinal strips are a first and a

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second strip equidistant from each other, and positioned away from the seam of the outer warp of said cigarette.

Information Disclosure Statement

The information disclosure statement filed July 27, 2007 fails to comply with 37 CFR 1.97(c) because it lacks a statement as specified in 37 CFR 1.97(e) or the fee set forth in §1.17(p). It has been placed in the application file, but the information referred to therein has not been considered.

Response to Arguments

Applicant's arguments, see page 7-9, filed June 6, 2007, with respect to Claims 13-21, 23-31, and 33-34 have been fully considered and are deemed in part persuasive.

First with respect to the rejection to claims 23 to 32 under 35 U.S.C. §102(b) over Bandel, Applicant argues that there is no teaching or suggestion that the disclosed tobacco sheet has application as a burn rate modifier.

Examiner disagrees with the basis of this argument. Examiner first notes that Applicants arguments appear drawn to specific limitations which are not reflected in the claims. On this point alone, Applicants arguments are deemed moot. Further, Applicant seems to argue an intended use for the claimed tobacco sheet article, stating that the prior art tobacco sheet is not taught to be applicable as a burn rate modifier. Since the instant argument is drawn to an intended use of a claimed product and

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Applicant has provided no material evidence that the prior art product can not function in the as said burn modifier, Applicants arguments are deemed moot.

Next, Applicant argues that Bandel teaches a tobacco sheet comprising 63.5% tobacco and that said composition can not be applied to the claimed sheet with a tobacco concentration range of about 15 to 40%. As clearly set forth by the Examiner, a tobacco sheet comprising 63.5% tobacco is in fact understood to read upon the claimed tobacco sheet comprising ABOUT 40% tobacco, absent any compelling showing to the contrary. Although not relied upon in the prior art rejection, it is the Examiners position that one of ordinary skill in the art would recognize that tobacco concentration in reconstituted tobacco sheets typically vary rather widely from negligible tobacco amounts to >99% wt concentrations. Applicant is directed to a typical teaching on reconstituted tobacco sheets by Montoya et al. (US 5,092,353) which provides evidence that typical tobacco sheet compositions may vary from "about 10 to about 90 (percent)" (Column 4, lines 19-31). Given the broad ranges typically encountered in the art, it is the Examiners position that 63.5% tobacco is appropriately interpreted in the present claim as about 40%.

With respect to Applicants newly added claim limitation wherein "the partial inner wrap strips are positioned away from the seam of the outer wrap of the cigarette", it is the Examiners position that said limitation is insufficient to patentably distinguish the claimed invention from the cigarette structure disclosed by the prior art. Pointing to a

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section of the Crooks disclosure (column 4, lines 16-20), Applicant argues that one preferred embodiment disclosed in the prior art reference necessarily excludes Crooks from teaching specific cigarette structure claimed by Applicant. Examiner simply finds no basis for Applicants allegations. Specifically, the preceding paragraphs (Column 3, lines 30-62) teach that multiple strips may be incorporated on the inner circumference of the wrapper, but the claim in no way restricts their respective placement with respect to the glue line. The instant limitation is either implicitly disclosed by the Crooks teachings or alternatively would have represented a minor and obvious extension over said teachings.

Applicant then argues that Crooks does not teach putting a flavorant into the partial inner wrap strip itself, but "merely reiterates the familiar technique of adding flavorant by casings or top dressings". On this point, the Examiner is unpersuaded. Specifically, Applicant has failed to provide any substantial evidence to show that the "techniques familiar to the skilled artisan" for applying a flavorant to the inner wrap do not result in the flavorant incorporated "in said inner wrap" as claimed.

Finally, Applicant asserts that claimed Tobacco sheet composition comprising a tobacco to binder agent ratio of about 1.0 to 1.0 "is far removed" from the ratio set forth in the prior art of approximately 4:1. On this point, Examiner has carefully considered the scope of Applicants disclosure to ascertain the particular metes and bounds covered by Applicants claim limitation of "about 1.0 to 1.0". Applicants Example 1 (pg 21)

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teaches 70 pounds tobacco : 70 pounds sodium alginate or identically a 1.0 : 1.0 tobacco to binder ratio. In view of the detailed examples presented in the instant specification, the prior art reference to Bandel which teaches a tobacco:binder ratio of approximately 4:1 does not properly read upon Applicants claimed composition.

Allowable Subject Matter

Claims 13-21, 23-31, and 33-34 are allowed.

The following is an examiner's statement of reasons for allowance:

In Applicants reply filed June 6, 2007, Applicant presented arguments in response to rejections set forth in the May 8, 2007 Office Action. Applicant specifically asserted that Bandel teaches a ratio of tobacco to binder agent of approximately 4:1...(which) is far removed from Applicant's ratio of about 1.0 to 1.0". Upon further search and careful consideration of the scope and content of the prior art, Examiner is in agreement with Applicants assertion.

The Examiner has discovered multiple teachings in the prior art which prepare a reconstituted tobacco comprising tobacco, filler, and binder compositions and particularly which read upon applicants claimed ranges set forth in claims 13 and 23. For example see Montoya (US 5,092,353) Column 4, lines 19-31, Jakob et. al. (US 5,129,408) Column 7, lines 4-24, and Casey (US, 5415,186) Column 15, lines 41-65. Further as cited in the previous Office Action, the prior art teachings of Bandel provide a tobacco sheet comprised of the specific claimed components, namely tobacco, wood

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pulp, glycerine, and sodium alginate in very similar concentrations to those claimed.

Finally, Keritsis (US 4,936,920) teaches that it is known to vary the binder concentration in order to vary the stiffness of the resultant tobacco sheet product (See figure 1, line 20 and line 22, and Column 6, lines 28-59).

After consideration of the collective scope of the prior art teachings, it is the Examiners position that none of these prior art references teach every limitation of the independent claims. Specifically none of the references alone or in combination teach the particular tobacco sheet composition wherein a binder to tobacco ratio is specified with sufficient accuracy to appropriately anticipate or render obvious the relatively narrow claimed ratio of about 1.0 to 1.0. In the prior art of record, tobacco to binder ratios typically vary from greater than 10:1 to approximately 4:1, and a supplemental teaching on common practice in the art (see Prowse et. al, British-American Tobacco Co. Ltd. (1993)) suggests that binders or adhesives are typically incorporated only in minor amounts of up to 15% on a tobacco weight basis. As indicated in the preceding section, Applicants sole example of the tobacco : binder ratio is a precise 1.0 to 1.0 ratio and therefore Examiner construes the instant claim as relatively narrow in scope even though Applicant relates the range as "about" 1.0 : 1.0.

The MPEP §2131.03 provides guidance on this matter by stating that, "When the prior art discloses a range which touches *>or< overlaps the claimed range, but no specific examples falling within the claimed range are disclosed, a case by case

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determination must be made as to anticipation. In order to anticipate the claims, the claimed subject matter must be disclosed in the reference with "sufficient specificity to constitute an anticipation under the statute." What constitutes a "sufficient specificity" is fact dependent. If the claims are directed to a narrow range, >and< the reference teaches a broad range, ** depending on the other facts of the case, it may be reasonable to conclude that the narrow range is not disclosed with "sufficient specificity" to constitute an anticipation of the claims. **>See, e.g., *Atofina v. Great Lakes Chem. Corp.*, 441 F.3d 991, 999, 78 USPQ2d 1417, 1423 (Fed. Cir. 2006)

Therefore, after careful consideration of the prior art teachings, Examiner agrees with Applicants assertion that the prior art does not teach nor fairly suggest with sufficient specificity the precise tobacco to binder ratio of "about 1.0:1.0" as claimed by Applicant.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason L. Lazorcik whose telephone number is (571) 272-2217. The examiner can normally be reached on Monday through Friday 8:30 am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on (571) 272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JLL



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